

REMARKS:

Claims 1-29 are currently pending in the application.

Claims 1-29 stand rejected under 35 U.S.C. § 103(a) over U.S. Publication No. 2002/0035511 A1 to Haji et al. ("*Haji*") in view of U.S. Patent No. 6,105,004 to Halperin et al. ("*Halperin*").

The Applicant respectfully submits that all of the Applicant's arguments and amendments are without *prejudice* or *disclaimer*. In addition, the Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, the Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. The Applicant further respectfully submits that by not responding to additional statements made by the Examiner, the Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by the Applicant are considered sufficient to overcome the Examiner's rejections. In addition, the Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 112:

The Applicant thanks the Examiner for withdrawing the rejection of Claims 3, 11, and 20 under 35 U.S.C. § 112, second paragraph.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-29 stand rejected under 35 U.S.C. § 103(a) over U.S. Publication No. 2002/0035511 A1 to Haji et al. ("*Haji*") in view of U.S. Patent No. 6,105,004 to Halperin et al. ("*Halperin*").

The Applicant respectfully submits that the ***amendments to independent Claims 1, 10, 19, 28, and 29 have rendered moot the Examiner's rejection of Claims 1-29***

and the Examiner's arguments in support of the rejection of Claims 1-29. The Applicant further respectfully submits that amended independent Claims 1, 10, 19, 28, and 29 in their current amended form contain unique and novel limitations that are not taught, suggested, or even hinted at in *Haji* or *Halperin*, either individually or in combination. Thus, the Applicant respectfully traverses the Examiner's obvious rejection of Claims 1-29 under 35 U.S.C. § 103(a) over the proposed combination of *Haji* or *Halperin*, either individually or in combination.

The Proposed *Haji-Halperin* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims

For example, with respect to amended independent Claim 1, this claim recites:

A **system for locally generating price quotes**, the system comprising:

a **server associated with a buyer**, wherein the server is operable to:

receive one or more pricing tools from one or more sellers, the one or more pricing tools operable to generate price quotes for one or more corresponding sellers;

locally store the one or more pricing tools received from the one or more sellers in a buyer database, such that the one or more pricing tools are locally accessible to the server associated with the buyer;

access a request for quote (RFQ) specifying an order comprising quantities of one or more items, the RFQ requesting a price quote for the order;

communicate the RFQ to the locally accessible one or more pricing tools;

using the locally accessible one or more pricing tools received from the one or more sellers, locally generate a price quote for the order; and

provide the locally generated price quote for the order for possible further action by the buyer. (Emphasis Added).

In addition, *Haji* or *Halperin*, either individually or in combination, fail to disclose each and every limitation of amended independent Claims 10, 19, 28, and 29.

The Applicant respectfully submits that *Haji* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding a **"system for locally generating**

price quotes" and in particular *Haji* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding a **"server associated with a buyer"** wherein the server is operable to **"receive one or more pricing tools from one or more sellers,** the one or more pricing tools operable to generate price quotes for one or more corresponding sellers". In particular, the Examiner equates **"receiv[ing] one or more pricing tools from one or more sellers"** recited in amended independent Claim 1 with the **system for receiving orders** disclosed in *Haji*. (4 January 2007 Office Action, Page 3). However, **the system for receiving orders disclosed in Haji** is merely the ability for the server in *Haji* to provide through a network a web page, and **does not include, involve, or even relate to receiv[ing] one or more pricing tools from one or more sellers**, as recited in amended independent Claim 1. (Paragraphs [0070-0075]).

In addition, the Examiner alleges that "*Haji* teaches user receives the pricing tool from a server for calculating the price of the selected items (§ 11, 75)." (18 May 2007 Final Office Action, Page 2). The Applicant respectfully disagrees. In fact, the Applicant respectfully submits that the Examiner has mischaracterized the teaching of *Haji*. For example, the Applicant respectfully directs the Examiner's attention to the cited portions of *Haji*:

The server transmits Web pages to the receiving terminal through the network. The server, the receiving terminal and the network may be used for any purposes or may have any functions. A Web page with a program to calculate a quotation added thereto is displayed on the receiving terminal of the user. When the user selects several products on the Web page, the program to calculate a quotation calculates the total sale price therefor based on the selection result and displays the same. By utilizing this Web page, calculation services can be provided to the user without giving a load to the server. (Paragraph [0011]).

When the Web page 10 is transmitted to the receiving terminal that is operated by the user, the user utilizes the Web page 10, whereby calculation of quotations can be executed for personal computers of various specifications and the results are displayed in real time. At that moment, since there is no need to communicate with the server 2, a carefully thought out quotation calculation service can be provided without giving a load to the server 2. Also, it is noted that the calculation of quotations on the receiving terminal 3 can be performed off-line. Therefore, when the user is in a dial-up connection, the connection may be once turned off, and when a desired

configuration for a computer is decided, the connection may be re-established, and a formal quotation request can be made. In this manner, the user can have sufficient time to consider and can also cut down the communication costs. (Paragraph [0075]).

The Applicant respectfully submits that the above cited portions of *Haji* does not teach, suggest, or even hint at a “user receives the **pricing tool** from a server for calculating the price of the selected items”, as alleged by the Examiner. (18 May 2007 Final Office Action, Page 2). (Emphasis Added). For example, *Haji* does not teach, suggest, or even hint at a **pricing tool** and since *Haji* does not teach, suggest, or even hint at a **pricing tool**, *Haji* cannot teach a “user receives the **pricing tool** from a server for calculating the price of the selected items”, as alleged by the Examiner. (18 May 2007 Final Office Action, Page 2). (Emphasis Added).

In addition to *Haji* not disclosing a **pricing tool**, *Haji* does not teach, suggest, or even hint at **calculating the price of the selected items** and since *Haji* does not teach, suggest, or even hint at **calculating the price of the selected items**, *Haji* cannot teach a “user receives the **pricing tool** from a server for **calculating the price of the selected items**”, as alleged by the Examiner. (18 May 2007 Final Office Action, Page 2). (Emphasis Added).

Furthermore, since *Haji* does not disclose a **pricing tool** or **calculating the price of the selected items** *Haji* cannot teach a “user receives the **pricing tool** from a server for **calculating the price of the selected items**”, as alleged by the Examiner. (18 May 2007 Final Office Action, Page 2). (Emphasis Added). Instead, the above cited portions of *Haji* merely disclose a “web page with a program to calculate a quotation added thereto is displayed on the receiving terminal of the user.” (Paragraph [0011]).

The Examiner further equates the “**seller**” recited in amended independent Claim 1 with the “**server**” disclosed in *Haji*. (18 May 2007 Final Office Action, Page 2). The Applicant respectfully disagrees. However, **the server disclosed in *Haji*** merely provides a web page, but **does not include, involve, or even relate to the one or more sellers**, as recited in amended independent Claim 1. (Paragraphs [0070-0075]).

In addition, the Examiner further asserts that “*Haji* explicitly gives an example of the functions that the server [of *Haji*] performs.” (18 May 2007 Final Office Action, Page 2). The Applicant respectfully submits that the Examiner has mischaracterized the teaching of *Haji*. For example, the Applicant respectfully directs the Examiner’s attention to the cited portions of *Haji*:

A network 1 in the figure is the Internet. It is noted that the description is made with reference to the Internet as an example. However, the present invention is also applicable to other networks such as a telephone network, an Intranet and the like. The network 1 connects to a server 2 and a receiving terminal 3. In this example, ***a system for receiving orders and selling personal computers and their peripheral equipment through the Internet is introduced.*** (Paragraph [0070]).

Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Haji* and amended independent claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent claim 1 from *Haji*.

The Applicant respectfully submits that *Haji* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding ***“access[ing] a request for quote (RFQ) specifying an order comprising quantities of one or more items, the RFQ requesting a price quote for the order”***. In particular, the Examiner equates ***“access[ing] a request for quote (RFQ) specifying an order”*** recited in amended independent Claim 1 with the ***Web page 10 displays lists of parts to be selected to the user using a form at the receiving terminal 3.*** The quotation calculation program adds prices of parts selected and displays the result as a quotation amount disclosed in *Haji*. (18 May 2007 Final Office Action, Page 4). However, ***the web page*** disclosed in *Haji* is ***merely a page containing active script that waits for the user to interact with it to manually input and/or select data but does not include, involve, or even relate to a request for quote (RFQ)*** as recited in amended independent Claim 1. (Paragraph [0074]). In contrast, the ***“request for quote (RFQ)”*** recited in amended independent Claim 1 ***is accessed by the one or more computers associated with the buyer*** and is therefore ***not a human user manually inputting data***. Thus, the Applicant respectfully submits that the equations

forming the foundation of the Examiner's comparison between *Haji* and amended independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent claim 1 from *Haji*.

The Applicant further respectfully submits that *Haji* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding “***communicat[ing] the RFQ to the locally accessible pricing tool***”. In particular, the Examiner equates “***communicat[ing] the RFQ to the locally accessible pricing tool***” recited in amended independent Claim 1 with the ***Web page 10 displays lists of parts to be selected to the user using a form at the receiving terminal 3***. The quotation calculation program adds prices of parts selected and displays the result as a quotation amount disclosed in *Haji*. (18 May 2007 Final Office Action, Page 4). However, as discussed above, because ***the web page*** disclosed in *Haji* is ***merely a page containing active script that waits for the user to manually select and input data, the web page of Haji does not include, involve, or even relate to a request for quote (RFQ)*** as recited in amended independent Claim 1. In contrast, the “***request for quote (RFQ)***” recited in amended independent Claim 1 ***is communicated by the one or more computers associated with the buyer and therefore is composed of computer readable data and is, therefore not a human user manually selecting or inputting data***. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Haji* and amended independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent claim 1 from *Haji*.

The Office Action Acknowledges that *Haji* Fails to Disclose Various Limitations Recited in Applicant's Claims

The Applicant respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Haji* fails to disclose the emphasized limitations noted above in amended independent claim 1. Specifically the Examiner acknowledges that *Haji* fails to teach “the specified order comprising ***quantities of one or more items***”. (18 May 2007

Final Office Action, Page 4). However, the Examiner asserts that the cited portions of *Halperin* disclose the acknowledged shortcomings in *Haji*. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in *Halperin*.

The Applicant respectfully submits that *Halperin* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding "**access[ing] a request for quote (RFQ) specifying an order comprising quantities of one or more items**, the RFQ requesting a price quote for the order". In particular, the Examiner equates "**quantities of one or more items**" recited in amended independent Claim 1 with the "**purchase information**" disclosed in *Halperin*. (18 May 2007 Final Office Action, Page 4). However, the "**purchase information**" disclosed in *Halperin* is merely displayed on a screen, but **does not include, involve, or even relate to the quantities of one or more items**, as recited in amended independent Claim 1. (Column 4, Lines 1-4). In contrast, the "**quantities of one or more items**" recited in amended independent claim 1 **is associated with a buyer for locally generating price quotes wherein a request for quote is accessed specifying an order which comprises quantities of one or more items**. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Halperin* and amended independent claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent claim 1 from *Halperin*.

In addition, the Examiner equates "**quantities of one or more items**" recited in amended independent Claim 1 with the statement that a "**display screen 33 shows purchase information, such as the item price, quantity, and the subtotal of all items already selected**" and that the "**consumer can read the price 61, its quantity 62, and the subtotal 63 of the entire purchase** so far as calculated by CPU 50 from the contents of record memory 55". (18 May 2007 Final Office Action, Page 2). However, the barcode reader display in *Halperin* merely displays the quantity of items scanned by the consumer during a trip through the supermarket, but **does not include, involve, or even relate to access[ing] a request for quote (RFQ) specifying an order comprising quantities of one or more items**, as recited in amended independent Claim 1. (Column 4, Lines 1-3 and Column 5, lines 38-41). Thus, the Applicant respectfully submits that the equations

forming the foundation of the Examiner's comparison between *Halperin* and amended independent claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent claim 1 from *Halperin*.

The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Haji-Halperin* Combination

The Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Haji* or *Halperin*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the specified order in *Haji's* teaching to include quantities of the ordered items as taught by *Halperin*". (18 May 2007 Final Office Action, Page 4). The Applicant respectfully disagrees.

The Applicant further respectfully submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Haji* or *Halperin*, either individually or in combination. The Examiner asserts that the motivation to combine the references as proposed would be "so that the buyer can have **better idea** of the total costs **of the order that have multiple purchased items**". (18 May 2007 Final Office Action, Page 4). (Emphasis Added). The Applicant respectfully disagrees. For example, how does "**hav[ing] a better idea**" allow the alleged specified order in *Haji's* to include quantities of the ordered items as allegedly taught by *Halperin* and to what extent does the Examiner purport that "**hav[ing] a better idea**" applies to the subject Application. ***The Applicant respectfully requests the Examiner to point to the portions of Haji or Halperin which contain the teaching, suggestion, or motivation to combine these references for the Examiner's stated purported advantage.*** The Applicant respectfully submits that the Examiner is using the subject Application as a template to formulate

reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the **prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the **Examiner has not adequately supported the selection and combination of Haji and Halperin to render obvious the Applicant's claimed invention.** The Examiner's unsupported conclusory statements that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the specified order in *Haji's* teaching to include quantities of the ordered items as taught by *Halperin*" and that "so that the buyer can have **better idea** of the total costs **of the order that have multiple purchased items**", **does not adequately address the issue of motivation to combine.** (18 May 2007 Final Office Action, Page 4). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, **the Office Action fails to provide proper motivation for combining the teachings of Haji and Halperin**, either individually or in combination.

The Applicant's Claims are Patentable over the Proposed Haji-Halperin Combination

Amended independent Claims 10, 19, 28, and 29 are considered patentably distinguishable over the proposed combination of *Haji* and *Halperin*, for at least the reasons discussed above in connection with amended independent Claim 1.

Furthermore, with respect to dependent Claims 2-9, 11-18, and 20-27: Claims 2-9 depend from amended independent Claim 1; Claims 11-18 depend from amended

independent Claim 10; and Claims 20-27 depend from amended independent Claim 19. As mentioned above, each of amended independent Claims 1 10, 19, 28, and 29 are considered distinguishable over *Haji* and *Halperin*. Thus, dependent Claims 2-9, 11-18, and 20-27 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicant respectfully submits that Claims 1-29 are not rendered obvious by the proposed combination of *Haji* and *Halperin*. The Applicant further respectfully submits that Claims 1-29 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of Claims 1-29 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-29 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.*** Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations.*** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, ***and not based on applicant's disclosure.*** *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability***, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination.

Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991; *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

A Request for Continued Examination (RCE) is being filed in electronically herewith to facilitate the processing of this deposit account authorization. **The Director is hereby authorized to charge the \$790.00 RCE fee, to Deposit Account No. 500777.** Although the Applicant believes no additional fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777.** If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777.**

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

20 August 2007
Date

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